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BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER	
SALCE, JASON P	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN KIKINIS and YAKOV KAMEN

Appeal 2010-002994
Application 09/661,164
Technology Center 2400

Before MARC S. HOFF, CARLA M. KRIVAK, and
ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-19, 26-34, 37, and 38. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

STATEMENT OF THE CASE

Appellants' claimed invention is directed to "[a] system and method for prioritizing the insertion of recorded media into a broadcast stream according to a comparison of priority indicators in the broadcast stream and in the recorded media insertion" (Spec. 22, Abstract).

Independent claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A set-top box, comprising:
>
> memory storing computer readable instructions that, when executed, cause the set top box to:
>
> receive a broadcast stream, a portion of the broadcast stream having a first priority indicator;
>
> receive media separate from the broadcast stream, the media having a second priority indicator greater than the first priority indicator;
>
> receive a signal configured to modify the first priority indicator from a first priority to a second priority;
>
> modify the first priority indicator from the first priority to the second priority in response to receiving the signal;
>
> determine whether the modified first priority indicator is greater than the second priority indicator; and
>
> replace the portion of the broadcast stream with the separate media in response to determining that the modified first priority indicator is lower than the second priority indicator.

REFERENCES and REJECTIONS

The Examiner rejected claims 1-6, 9-16, 18, 26-31, 33, and 34 under 35 U.S.C. § 103(a) based upon the teachings of Reynolds (U.S. Patent Application Publication No. 2001/0037500 Al, published November 1, 2001, filed March 27, 2001), Gordon (U.S. Patent Application Publication No. 2001/0014975A1, published August 16, 2001, filed Apr. 16, 1999), and Zigmond (U.S. Patent No. 6,698,020 B1, issued February 24, 2004, filed June 15, 1998).

The Examiner rejected claims 7, 19, and 37 under 35 U.S.C. § 103(a) based upon the teachings of Reynolds, Gordon, Zigmond, and Blackketter (U.S. Patent Application Publication No. 2002/0056129 Al, published May 9, 2002, filed October 5, 1999).

The Examiner rejected claims 8, 17, and 32 under 35 U.S.C. § 103(a) based upon the teachings of Reynolds, Gordon, Zigmond, and Bullock (U.S. Patent No. 5,070,404, issued December 3, 1991, filed May 15, 1990).

The Examiner rejected claim 38 under 35 U.S.C. § 103(a) based upon the teachings of Reynolds, Gordon, Zigmond, and Robinett (U.S. Patent No. 6,351,474 B1, issued February 26, 2002, filed Jan. 14, 1998).

ISSUES

The first issue is whether the Examiner articulated a rational underpinning to support the legal conclusion of obviousness in modifying Reynolds in view of Gordon and further in view of Zigmond.

The second issue is whether Robinett teaches or suggests the limitations of: "determin[ing] that the first priority indicator is greater than the second priority indicator prior to receiving the signal" and "delaying the

insertion of the separate media into the broadcast stream until the first priority indicator is modified" as recited in claim 38.

PRINCIPLES OF LAW

"'The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.'" *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007)).

The Supreme Court stated that "'[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR*, 550 U.S. 398 at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted).

ANALYSIS

Claims 1-19, 26-34, and 37

Appellants argued that the Examiner failed to provide a reason why one of ordinary skill in the art would place the intelligence for resolving priority conflicts as taught by Gordon in a set-top box receiver (App. Br. 5). Appellants explain that the purpose of Gordon is to alleviate bandwidth and

storage requirements of an interactive television network by using local servers to resolve priority conflicts and to store subsets of data objects (*see* ¶ [0011] and App. Br. 5). Appellants assert that placing such a burden on the set-top boxes in Gordon would reduce the efficiencies sought by Gordon in using the local servers to perform such tasks (App. Br. 5).

We do not agree with Appellants. The Examiner relied on Gordon for the teaching of receiving a signal configured to modify the first priority indicator from a first priority to a second priority, modifying the first priority indicator from the first priority to the second priority in response to receiving the signal and causing the receiver of the system to execute the functions based on executable instructions (Ans. 4). We agree with the Examiner that Gordon teaches a method of changing priorities of viewable data objects dynamically (i.e., changing first priority to a second priority) in response to a received control signal (*see* ¶ [0029]), Ans.4 and Ans. 15-16). We also agree with the Examiner that it would have been a predictable result to modify the receiver of Reynolds to execute the changing priorities as taught by Gordon to adjust how to distribute programs based on viewing trends and events (*see* Gordon, ¶¶ [0007], [0029] and Ans. 4). The priority levels would be compared as taught by Reynolds to determine if substitution would take place (*see* Reynolds, ¶ [0037]) (Ans. 5). The Examiner relied on Zigmond for teaching a particular receiver being a set-top box with executable instructions (col. 7, ll. 42-49) to perform the functions of the received control signal as taught by Gordon (Ans. 5).

In other words, the combination of familiar elements (i.e., set top box receiver to execute instructions) according to known methods (i.e., instructions pertaining to a known method of changing the priorities of

viewable data objects) is likely to be obvious when it does no more than yield predictable results (i.e., changing viewable data objects based on viewing trends or events). *See KSR*, 550 U.S. at 416.

Thus, the Examiner provided some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (i.e., changing priorities of viewable data objects in the receiver of choice, such as a set top box, would change the viewable data objects based on viewing trends or events). *See KSR*, 550 U.S. at 418.

The Examiner does not have to rely on the same purpose as Gordon, such as alleviating bandwidth and storage requirements of an interactive television network, by using local servers to use the changing priorities, because the Examiner is simply relying on the known method of changing the priorities. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, but rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. *See Keller*, 642 F.2d at 425.

Accordingly, we will affirm the Examiner's rejections of claim 1 and for the same reasons the Examiner's rejections of claims 2-19, 26-34, and 37 for which Appellants repeat the same arguments (App. Br. 5-6).

Claim 38

Appellants argue that Robinett does not teach or suggest the limitations to "determine that the first priority indicator is greater than the second priority indicator prior to receiving the signal; and delaying the insertion of the separate media into the broadcast stream until the first priority indicator is modified" as recited in claim 38.

Appellants argue that:

> Specifically, a PID (i.e., packet identifier) mapping does not constitute separate media that is inserted into a broadcast stream. Additionally, nowhere does Robinett teach or suggest that the insertion of the separate media is delayed until the first priority indicator is modified. Not only does the PMT or CAT fail to describe a priority indicator, Robinett does not teach or suggest that insertion is delayed until the PMT or CAT is modified.

(App. Br. 7).

We are persuaded by this Argument as we do not agree with the Examiner's analogy between the packet identifier (PID) and the separate media inserted into the broadcast stream.

Accordingly, we will reverse the Examiner's rejection of claim 38.

CONCLUSIONS

The Examiner articulated a rationale underpinning to support the legal conclusion of obviousness in modifying Reynolds in view of Gordon and further in view of Zigmond.

Robinett does not teach or suggest the limitations of:

"determin[ing] that the first priority indicator is greater than the second priority indicator prior to receiving the signal" and "delaying the insertion of the separate media into the broadcast stream until the first priority indicator is modified" as recited in claim 38.

DECISION

The Examiner's decision rejecting claims 1-19, 26-34, and 37 is affirmed. The Examiner's decision rejecting claim 38 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R.§ 1.136(a)(1)(iv)(2010).

AFFIRMED-IN-PART

llw